

### **REMARKS**

Claims 1-27 are pending in this application and are believed to be distinguishable over the cited prior art, including Katz et al., U.S. Patent No. 5,926,624 and the newly discovered art, Kanota et al., U.S. Patent No. 5,991,500. As a result, no claim has been amended herein.

Claims 1, 6, 8-9, 11-13 and 15-16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Katz et al., U.S. Patent No. 5,926,624 in view of newly discovered art, Kanota et al., U.S. Patent No. 5,991,500 for reasons stated on pages 3-5 of the Office Action (Paper No. 20070716). In support of the rejection of Applicants' base claims 1, 8 and 16, the Examiner asserts that Katz '624, as a primary reference, discloses,

“at least one original content, a remake content based on at least one original content; (Katz, Col. 6 Lines 47-50, selected preview clips) and copying right information corresponding to the remake content, wherein the copyright information includes original copyright information which, when processed by a processor, is used to identify at least a copyright owner of the original content and remake copyright information (Katz, Col. 7 Lines 10-16].

The Examiner has now admitted (for the first time) that Katz '624 does **not** disclose,

"remake copyright information which, when processed by the processor, causes the processor to identify at least a maker of the remake content representing a user that is different from the copyright owner of the original content."

Nevertheless, the Examiner has relied upon a newly discovered art, Kanota et al., U.S. Patent No. 5,991,500, at column 2, lines 28-45, for allegedly disclosing the missing features, that is, the "remake copyright information which, when processed by the processor, causes the processor to identify at least a maker of the remake content representing a user that is different from the copyright owner of the original content."

However, the Examiner's reliance on both Katz '624 and Kanota '500 is misplaced and, likewise, the Examiner's assertions of the alleged teachings based on katz '624 Kanota '500 are simply incorrect and should be withdrawn for reasons discussed herein below.

Base claims 1, 8 and 16 clearly define a recording medium which comprises two types of information: (1) remake content based on at least one original content, as shown in FIG. 1; and (2) copyright information, as shown in FIG. 1, including both (a) original copyright information

which, when processed by an apparatus, causes the apparatus to identify at least a copyright owner of the original content, and (b) remake copyright information which, when processed by an apparatus, causes the apparatus to identify at least a maker of the remake content, as shown in FIG. 4. This way the copyright of the original content can be advantageously protected, while the personal use rights of an individual user on the original content can be guaranteed.

In contrast to Applicants' base claims 1, 8 and 16, Katz '624 only discloses a computer network based digital information library system, as shown in FIG. 2, in which a client computer system 214 or a mobile playback system 212 at a client site 210 can access a library server 260 for an indexed collection of digital information obtained from different sources, such as books, daily news, entertainment feeds, conferences and educational sources, via a distribution network 240 at a library site 250.

At the library site 250, an authoring system 280 is used to edit, index, compress, scramble, segment, and catalog digital information content into digital information files for storage on the library server 260. Such an authoring system 280 can also be used to partition digital information content into segments, which can be identified, searched, and skipped over if desired. As shown in FIG. 3, the authoring system 280 contains a preview generator 232 which generates preview clips 324 for providing short pre-generated portions of digital information content used to give a consumer a sense of the content of a particular digital information file. As further described on column 6, lines 42-68 of Katz '624,

"[T]he raw digital information content 310 is also fed to template header generator 312. Each digital information file maintained by the library server 260 includes other descriptive information used to identify the file's content and to provide information used to process the digital information within the file. **Each digital information file includes a template header**, a descrambling map, selected preview clips, and the digital information programming itself. In the preferred embodiment, the template header comprises a number of attributes corresponding to the digital information in the file. For example, the digital information may be audio information generated from the content of a book or other published work. In this example, the audio file template header contains attributes including: 1) the title of a book, volume, or medium from which the digital information content originated, 2) the legal copyright associated with the digital information content, 3) audible title(s) of the content, 4) a table of contents of the content, and 5) playback settings for appropriately playing or rendering the digital information. The table of contents contains content navigation information including but not limited to: the number of chapters, the length of the program, and information indicative of the relevant content sections. The table of contents is generated with input from authoring system operator 305 or automatically by analysis of digital information content 310."

As described by Katz '500, such an authoring system 280 is only used at a library site 250 to edit, index, compress, scramble, segment, and catalog digital information content into digital information files for storage on the library server 260. Moreover, the information transferred to a client computer 214 at a client site 210 does **not** include any remake copyright information.

Nevertheless, the Examiner cites column 7, lines 10-16 of Katz '624 for allegedly disclosing the use of "remake copyright information". However, the cited column 7, lines 10-16 of Katz '624 simply refers to the digital information files that have been edited, indexed, compressed, scrambled, segmented, and cataloged by the authoring system 280 at a library site 250 for downloading to the requesting client computer 214 at the client site 210. Again, there is **no** disclosure or suggestion anywhere in Katz '624 of Applicants' claimed "remake copyright information [that is used to identify at least a maker of the remake content representing a user that is different from the copyright owner of the original content]" as expressly defined in Applicants' base claims 1, 8 and 16.

As a secondary reference, Kanota '500 only discloses a serial copy management system (SCMS) for a video signal, as shown in FIG. 1, in which the copying of a video signal is controlled so as to permit a consumer to make one copy directly from a video signal (whether that video signal is broadcasted or reproduced from a video tape or video disk), but a copy of the copy (that is a re-recording of the copy) may be prohibited. As described on column 2, lines 1-14 of Kanota '500,

"[F]or example, a first generation [copying] may be permitted but a second generation [copying] may be prohibited. As another example, first and second generations may be permitted but a third generation may not (i.e. a recording and a re-recording may be permitted but a re-re-recording may be prohibited). In the foregoing copy protection schemes, if a video signal is permitted to be copied, a copy of the copied signal may be made and successive generations likewise may be made. But if a video signal is prohibited from being copied, even a single generation copy cannot be made."

In addition, as further described on column 2, lines 28-45 of Kanota '500, copy protection for a video signal is accomplished by superposing in a single line interval of a single field (or different line intervals in different fields) of the video signal which does not contain useful picture information, as shown in FIG. 1, both a copyright information signal S1 (which indicates whether

the viewable picture that may be produced from the video signal is subject to copyright) and a copy generation signal S2 (which indicates the number of successive generations of copies that can be made from the video signal). In addition, a copy generation signal detector is used to selectively decrement the number of successive generations of copies indicated by the copy generation signal, thereby controlling subsequent re-recording of the video signal.

Both the copyright information signal S1 and the copy generation signal S2 can be expressed in terms of single bit signals or plural bit signals. For example, as shown in TABLE 1, in column 7, lines 45-50 of Kanota '500, **S1** and **S2** can be expressed in terms of "1" and "0" which dictate whether copying is permitted or prohibited. If the copyright information signal S1 is not subject to copyright law, S1 is set to "0", then all copies will be permitted; however, if S1 is set to "1", then copying will only be permitted based on the setting of the copy generation signal S2.

However, there is **no** disclosure in the cited column 2, lines 28-45 or anywhere else in Kanota '500 of Applicants' claimed "remake copyright information" which, when processed by a processor, causes the processor to identify at least a maker of the remake content representing a user that is different from the copyright owner of the original content, as shown in FIG. 4, which can ensure copyright protection of the original content, while securing the personal use rights of an individual user on the original content, as generally defined in Applicants' base claims 1, 8 and 16.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Examiner must show that the prior art reference (or references when combined) must teach or suggest all the claim limitations, and that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, provided with a reasonable expectation of success, in order to arrive at the Applicants' claimed invention. The requisite motivation must stem from some teaching or suggestion to make the claimed combination must be found in the prior art, and **not** based on Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2143. Moreover, any deficiencies in the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge". See In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002).

In the present situation, both Katz '624 and Kanota '500 fail to disclose and suggest key

features Applicants' base claims 1, 8 and 16. Therefore, Applicants respectfully request that the rejection of claims 1, 6, 8-9, 11-13 and 15-16 be withdrawn.

Dependent claims 2-5, 7, 19-22 and 26 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Katz et al., U.S. Patent No. 5,926,624 and Kanota et al., U.S. Patent No. 5,991,500 and in view of Fuchigami et al., U.S. Patent No. 5,960,398 for reasons stated on pages 5-7 of the Office Action. According to the Examiner, Fuchigami '398, as another secondary reference, is cited for allegedly suggesting the use of copyright information that includes a producer code of an apparatus used in making the remake content (Fuchigami, Col. 5 Lines 46-56, SID). However, the rejection is improper because, even if Fuchigami '398 is incorporated into the computer network based digital information library and delivery system as disclosed by Katz '624, the proposed incorporation still does **not** arrive at Applicants' claims 2, 3, 4, 5, 7, 19, 20, 21, 22 and 26. This is because Fuchigami '398 only discloses a copyright information embedding system, as shown in FIG. 1, in which copyright information for copyright protection can be embedded into digital audio signal without deterioration of analog audio reproduced. As acknowledged on column 1, lines 44-48 of Fuchigami '398, conventional system used to embed copyright data into digital data has the drawback in that digital-to-analog (D/A) conversion of the digital data into analog audio data would cause reproduced sound quality to be deteriorated or changed uncomfortably. Again, like Katz '624 and Kanota '500, Fuchigami '398 does **not** disclose or suggest Applicants' efforts to reproduce from a recording medium: 1) remake content based on at least one original content, as shown in FIG. 1; and 2) copyright information, as shown in FIG. 1, that has both (a) original copyright information on the original content, and (b) remake copyright information on the remake content, which can ensure copyright protection of the original content, while securing the personal use rights of an individual user on the original content, as generally defined in the base claims. In view of these reasons and reasons previously discussed, Applicants respectfully request that the rejection of claims 2-5, 7, 19-22 and 26 be withdrawn.

Dependent claims 17-18, 24-25 and 27 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Katz et al., U.S. Patent No. 5,926,624 and Kanota et al., U.S. Patent No. 5,991,500 and in view of Bersson, U.S. Patent No. 6,081,897 for reasons stated on pages 7-10 of the Office Action. Likewise, dependent claim 23 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Katz et al., U.S. Patent No. 5,926,624, Kanota et al., U.S. Patent No. 5,991,500 and Bersson, U.S. Patent No. 6,081,897, as applied to claims 17, 18, 24

and 27, an in further view of Fuchigami et al., U.S. Patent No. 5,960,398 for reasons stated on pages 10-12 of the Office Action. Since these rejections are predicated upon the correctness of the rejection of their respective parent claims, Applicants respectfully traverse these rejections primarily based on the same reasons discussed against the rejection of their respective parent claims.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney at the Washington DC office at (202) 216-9505 ext. 232.

To the extent necessary, Applicants petition for an extension of time under 37 CFR §1.136. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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